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EXAMINER

CHIN, PAUL T

ART UNIT PAPER NUMBER

3652

DATE MAILED: 02/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/623,236

Applicant(s)

ARROTTA, GEORGE

Examiner

PAUL T. CHIN

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 November 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 9-19 is/are rejected.
- 7) ☒ Claim(s) 2-8 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 July 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Applicant's amendment and the arguments, filed November 22, 2004, have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Hamilton (4,819,137), O'Kane et al. (5,615,920) in view of Twachtman (2,993,723), and O'Kane et al. (5,615,920) and Twachtman (2,993,723) in view of Schneider et al. (5,799,999). A non-final office action follows as below.

Drawings

2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the "*switch module at a distal end of the tubular section*" (Claim 1, not shown in Fig. 1), "*a switch member*" (claim 15, not shown in Fig. 1), and "*a plastic coated helix coil*" (claim 12) must be shown or the feature(s) canceled from the claim(s). No new matter should be entered. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not

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accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Objections

3. Claim 3 and 11 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim.

Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claim 3 recites "electrically conducting insert disposed in the tubular section" (Claim 3) and "power supply and switch module" (Claim 11).

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 9-16 and 19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1 and 19 recite "*a switch module attached to a distal end of the tubular section*" (not shown in figure 1) and claim 15 recites "*a switch member*". It is not clearly understood how "the switch" and "the switch module is attached to the distal end of the tubular section". Moreover, the meaning of the phrase "*a compact electromagnetic tool securable to a magnetic object*" (claims 9 and 13) is unclear the claimed language of "compact electromagnetic tool". It is understood that the electromagnetic tool as shown in figure 1 is a compact tool. Further, the exact meaning of the phrase "*inserting the tubular section into a compact electromagnetic tool in a friction fit*" is also not clearly understood as to how the "tubular section" is inserted into "the compact electromagnetic

tool". There is no antecedent basis for "said stop cap" (claim 11) or "said compact electromagnetic tool" (claim 12). Note that claim 12 depends on claim 8 and a limitation "a compact electromagnetic tool" is recited in claim 9. Therefore, it appears that claim 12 should depend on claim 9 (instead of claim 8).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1, 13, and 17, as best understood, are rejected under 35 U.S.C. 103(a) as being unpatentable over O'Kane et al. (5,615,920) (see PTO-892) in view of Twachtman (2,993,723).

O'Kane et al. (5,615,920) discloses a telescoping retrieving device comprising an end cap (28), an end section (see **Exhibit A**) being connected to the end cap, a tubular section (34,34) slidably to receive the end section, an electrical conducting insert (20) (Fig. 1) disposed through the tubular section and the end section; the insert being connected to a power supply (18) and a switch module (Fig. 1). O'Kane et al.

(5,615,920) does not clearly show that the end section and the tubular section are made of a non-magnetizable material. However, Twachtman (2,993,723) discloses a magnet and a cylinder casing (14) of a non-magnetic material, enclosing the magnet (Col 2, lines 25-29). Accordingly, it would have been obvious design choice to provide a non-magnetic material on the tubular section (34) of O'Kane et al. (5,615,920) as taught by Twachtman (2,993,723) so that the modified O'Kane et al. (5,615,920) would not attract the metal object by the tubular sections.

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Re claim 13, the modified O'Kane et al. (5,615,920) shows a springly supported switch (26) as shown in figure 1.

Re claim 17, the modified O'Kane et al. (5,615,920) does not show that the module is covered with a non-conducting material. However, it would have been obvious design choice to provide a non-conducting material, such as plastic, on the module of the modified O'Kane et al. (5,615,920) to cover the module and to preserve the energy from the battery.

8. Claim 18, as best understood, is rejected under 35 U.S.C. 103(a) as being unpatentable over O'Kane et al. (5,615,920) and Twachtman (2,993,723), as applied to claim 1, and further in view of Schneider et al. (5,799,999) (see PTO-892).

The modified O'Kane et al. (5,615,920), as presented in section 7 above, does not show a covering means to magnetically shield the magnet. However, Schneider et al. (5,799,999) discloses a covering means (20) to magnetically shield the magnet (Col 2, lines 50-53). Accordingly, it would have been obvious design choice to provide a covering means on the outer portion of the magnet (28) of the modified O'Kane et al. (5,615,920) as taught by Schneider et al. (5,799,999) to magnetically shield the magnet (28).

9. Claims 1 and 13, as best understood, are rejected under 35 U.S.C. 103(a) as being unpatentable over Hamilton (4,819,137).

Hamilton (4,819,137) discloses a telescoping device comprising an end cap (22) made of steel (Col 4, lines 9-15) which is a magnetizable material, an end section (24,28) being connected to the end cap, a tubular section (26,16) slidably to receive the end

section, a spring (32), which can be considered as an electrical conducting insert, disposed through the tubular section (26,16) and the end section (24), the insert being connected to a power supply (40) and a switch module (18,20,34) (Fig. 3). Hamilton (4,819,137) shows that the tubular section (26,16) is made of steel and a battery module is made of aluminum, which is a non-magnetizable material, but does not show that the end section (24,28) and the tubular section (26,16) are made of a non-magnetizable material. However, it would have been obvious design choice to provide a non-magnetic material such as aluminum or stainless steel, on end section and the tubular section of Hamilton (4,819,137) to provide a heavier and stronger device and also to prevent corrosion.

Re claim 13, the modified Hamilton (4,819,137) shows a spring (48) compressing the battery (40) and also substantially supporting the bushing (34) of the switch (18,20) as shown in figure 3.

Allowable Subject Matter

10. Claims 2-8 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

11. Claims 9-12 and 14-16 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

12. Claim 19 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action.

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Response to Arguments

13. Applicant's arguments with respect to claims 1-19 have been considered but are moot in view of the new ground(s) of rejection.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to PAUL T. CHIN whose telephone number is (703) 305-1524. The examiner can normally be reached on MON-THURS (7:30 -6:00 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, EILEEN LILLIS can be reached on (703) 308-3248. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



PAUL T. CHIN
Examiner
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